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Einar Stole
MILBANK, TWEEED, HADLEY & MCCLOY LLP
INTERNATIONAL SQUARE BUILDING
1850 K STREET N.W., SUITE 1100
WASHINGTON DC 20006

In re Application of	:	
Jensen-Jarolin	:	Decision on Petition
Serial No.: 10/501,402	:	
Filed : 3 January 2005	:	
Attorney Docket No.: 37488.00400US	:	

This letter is in response to the Renewed Petition under 37 C.F.R. 1.144 and 1.181 filed on 21 March 2008 requesting reconsideration of the restriction requirement dated 17 May 2007.

BACKGROUND

This application was filed as a national stage under 35 USC 371 and as such, is entitled to PCT unity of invention rules.

On 17 May 2007, the examiner required a restriction between Groups I and II and an election of species among antacids, H₂-receptor and proton pump inhibitors.

On 18 June 2007 applicants elected Group I and the species of antacids.

On 21 December 2007, the examiner considered the traversal and made the election of species FINAL. Claims 11-16, 21-22 and 30-31 were rejected under 35 USC 102(e) as being anticipated by Vande-Velde. Claims 23-25 were rejected under 35 USC 103(a) as being unpatentable over Vande-Velda in view of Martin. Claims 23 and 26-29 were rejected under 35 USC 103(a) as being unpatentable over Vande-Velda in view of Kricek.

On 21 March 2008, applicants filed this petition.

DISCUSSION

The file history and petition have been considered carefully.

The restriction required between Group I and Group II is not at issue at this time because applicants have provided no reasons traversing the restriction between Group I and II.

PCT Rules 13.2 states that:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The criteria for determining the concept of "contribution over the prior art" is further discussed in Chapter 10 of the International Search and Preliminary Examination Guidelines:

Rule 13.2; AI Annex B, Part 1(b)

10.02 Whether or not any particular technical feature makes a "contribution" over the prior art, and therefore constitutes a "special technical feature," is considered with respect to novelty and inventive step. For example, a document discovered in the international search shows that there is a presumption of lack of novelty or inventive step in a main claim, so that there may be no technical relationship left over the prior art among the claimed inventions involving one or more of the same or corresponding special technical features, leaving two or more dependent claims without a single general inventive concept.

Applicants argue that the species have unity of invention because they have a common property or activity, in this case, a gastric acid reducing substance, and because they all belong to a recognized class of chemical compounds in the art to which the invention pertains.

This is not persuasive. The fact that the claim recites these items as a listing of individuals in the alternative without using a single generic term or phrase to encompass them all, demonstrates that there is no art recognized grouping for the collection of "antacids, H₂-receptors and proton pump inhibitors."

Moreover, PCT Rule 13.2 requires that for unity of invention, the species must share a special technical feature which makes a contribution over the prior art. Chapter 10 of the ISPE Guidelines makes it clear that the contribution must be both in terms of novelty, which corresponds to anticipation under US practice, and inventive step, which corresponds to unobviousness under US practice. The rejection under 35 USC 102(e) set forth in the first Office action on the merits are evidence that the invention is anticipated by the prior art. The rejections made under 35 USC 103(a) are evidence that the invention is obvious in view of the prior art.

Furthermore, MPEP 803.02 only requires an examiner to move on to the examination of a second and subsequent species when the elected species is in condition for allowance. See this portion of MPEP 803.02:

...If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the nonelected species would be held withdrawn from further consideration. A second action on the rejected claims can be made final unless the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 706.07(a).

At present, claims directed to the elected species are found unpatentable in view of a 35 USC 102 rejection. As such, the elected species does not make a contribution over the prior art and the examiner is not obliged to extend search and examination to a second or subsequent species.

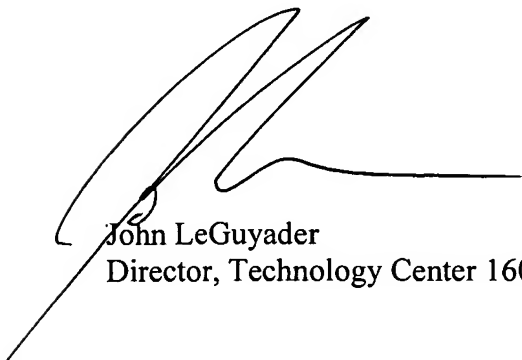
DECISION

The petition filed under 37 CFR 1.144 and 1.181 on 21 March 2008 is **DENIED**.

The application will be forwarded to the examiner to consider the papers filed 21 March 2008 and to prepare an Office action consistent with this petition decision.

Any request for reconsideration should be filed within TWO MONTHS of the mail date of this Petition Decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-272-8300.



John LeGuyader
Director, Technology Center 1600